PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number
24207-12225

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on June 19, 2008

Signature /Christopher King/

Typed or printed name

Christopher-Charles P. King

Application Number	Filed
10/783,378	February 20, 2004

First Named Inventor

Hartmut Neven, Sr.

Art Unit	Examiner
2622	Nicholas Giles

This request is being filed with a notice of appeal.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 of 1 form is submitted.

ATTACHMENT TO THE PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pre-appeal review is requested because the rejections in the March 25, 2008 Final Office Action are improper and without factual or legal basis. Applicant respectfully requests that the Panel indicate that claims 1-31 recite allowable subject matter.

I. Status of the Claims

Claims 1-31 are pending and stand rejected. Claims 11-16, 25, and 28 are rejected under 35 USC 112, Paragraph 2. Claims 1-8, 11-15, 17-19, and 21-28 are rejected under 35 USC § 102(e) as allegedly being anticipated by Boncyk et al., WO 03/041000. Claims 9, 10, 16, and 20 are rejected under 35 USC § 103(a) as allegedly being unpatentable over Boncyk et al. Claims 29-31 are rejected under 35 USC § 103(a) as allegedly being unpatentable over Boncyk et al. in view of Waibel, U.S. Pub. No. 2003/0164819. After the Office Action of March 25th, claims 11, 28, 29, and 31 were amended on May 29, 2008 to correct minor typographical errors.

II. Rejection of claims 1-8, 11-15, 17-19, and 21-28 under 35 USC 102(e) in view of Boncyk

Independent claim 17 recites a computer implemented method for image-based searching in which a search engine provides a set of search results in response to receipt of a symbolic identifier. Specifically, claim 17 recites a computer implemented method for image-based searching, comprising:

> receiving at a computer server, an input image from a user device remotely located from the server;
> providing from the computer server the input image to an image recognition system;
> receiving at the computer server from the image recognition system a symbolic identifier associated with the input image;
> providing from the computer server the symbolic identifier **to a search engine** as a query;

> receiving at the computer server **from the search engine** a set of search results associated with the symbolic identifier; and
> transmitting from the computer server a plurality of the search results to the user device.

As claimed, a computer server provides an input image to an image recognition system and receives a symbolic identifier associated with the input image. The symbolic identifier is provided to a search engine as a query, and the computer server receives from the search engine a set of results associated with the symbolic identifier. Thus, for example, the image recognition system could identify an image of the Eiffel Tower and provide plain text, e.g. "Eiffel Tower," as the symbolic representation to the search engine. The search engine then accepts the symbolic representation "Eiffel Tower" and in response provides a list of links to web sites containing information relating to the Eiffel Tower. (*See, e.g.,* paragraph 0003 of the specification).

The cited reference, Boncyk, discloses identifying an object from a database based on a digitally captured image. Boncyk fails, however, to contemplate the use of a search engine, instead only disclosing retrieving objects from a traditional database. (Boncyk, page 1). The Examiner cites Boncyk 9:40-10:5, but this portion merely shows that an image may be pre-associated with an URL, which is returned in response to matching the image; it does not disclose providing the symbolic identifier to a search engine as a query, or receiving from the search engine a set of search results, as claimed.

Indeed, a later Boncyk application, Application Serial No. 11/204,901, filed August 15, 2005,[1] and a continuation-in-part of Application Serial No. 09/992,942, filed November 5, 2001, explicitly states:

> Several years ago the present inventors pioneered the concept of using digitally captured images to identify objects within the images, and then using such identifications to retrieve information from various databases.
> . . .

[1] Note that the filing date of the present application is February 20, 2004, and thus precedes the filing date of Boncyk's Application Serial No. 11/204,901, the first Boncyk application to mention the use of search engines.

> It was not appreciated, however, that one could integrate these concepts with the searching capabilities of standard Search Engines.
> . . .
> The present invention provides apparatus, systems and methods in which: . . . (c) the search criteria are submitted to a Search Engine to obtain information of interest[.] (citation, emphasis added)

Thus, Boncyk himself, as an inventor being without question one of at least ordinary skill in the relevant art, admits that the claimed use of search engines was not contemplated—that is, not disclosed or suggested—in his own earlier applications—including the Boncyk reference replied upon by the Examiner. As noted by the Federal Circuit, "[w]hen prior art contains apparently conflicting references, the Board must weigh each reference for its power to suggest solutions to an artisan of ordinary skill. … The Board, in weighing the suggestive power of each reference, must consider the degree to which one reference might accurately discredit another." *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991). Since Boncyk himself expressly states in his later patent application that the integration of image identification with the searching capabilities of standard search engines was not previously contemplated by him, it is clear legal error for the Examiner to substitute his own judgment as to what Boncyk WO 03/041000 discloses over the very admissions of Boncyk himself. Rather, the Examiner must weigh the admissions of Boncyk Application 11/204,901 when interpreting Boncyk WO 03/041000. These admissions—which are clearly against Boncyk's own interests—outweigh the Examiner's attempted interpretation of Boncyk WO 03/041000. Boncyk himself is the best judge of what his application WO 03/041000 discloses.

Thus, the rejection of independent claim 17 is legal error. Independent claims 1, 11, 18, and 28 all recite the use of a search engine and are rejected in a manner similar to that of claim 17. Thus, their rejections likewise constitute legal error for at least the same reasons discussed above.

III. Rejection of claims 9, 10, 16, and 20 under 35 USC 103(a) in view of Boncyk

Claims 9, 10, 16, and 20 depend, directly or indirectly, from independent claims 1, 11, or 18, and thus their rejections constitute legal error for at least the same reasons discussed above. Additionally, claim 10 recites that the claimed system allows "providers of information to independently make new entries in the image processing system for the purpose of allowing their data to be retrieved by means of image entry." Claims 16 and 20 recite that an image recognition server is further adapted to receive images from a user device and to store the received images as reference images. In rejecting these claims, the Examiner takes official notice that it was allegedly well known in the art to update databases with new information (claim 10) and to update image databases with new images that can be searched (claims 16 and 20).

However, as noted by the court in *In re Ahlert*, "[a]ssertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art." *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). Similarly, the MPEP notes that "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." MPEP § 2144.03. The claimed receipt and storage of reference images in an image recognition system is hardly "capable of instant and unquestionable demonstration as being well-known;" rather, it is precisely the type of esoteric technology for which a citation to a standard reference work must be provided, as required by *Ahlert*. Thus, the present rejection of claims 10, 16, and 20, without more, is legally inadequate for this additional reason.

IV. Rejection of claims 29-31 under 35 USC 103(a) in view of Boncyk and Waibel

Independent claims 29 and 31 recite the use of a search engine and are rejected in a manner similar to that of claim 17, the Examiner not considering the admission of Boncyk

Application 11/204,901. Further, the Waibel reference, cited as allegedly disclosing specific features such as text translation, no more discloses the claimed search engine than does Boncyk itself, nor does the Examiner suggest that it does. Thus, the rejections of these claims likewise constitute legal error for at least the same reasons discussed above.

V. Summary

Based on the foregoing, Applicant respectfully submits that the pending rejections suffer from clear deficiencies. Accordingly, Applicant requests that the rejections of independent claims 1, 11, 17, 18, 28, 29, and 31, and their respective dependent claims, be withdrawn.

Respectfully Submitted,
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Date: June 19, 2008 By: /Christopher King/

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